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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,544	05/18/2005	Moreno Predieri	1014.1046	7850

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POLLACK, P.C.  
THE CHRYSLER BUILDING  
132 EAST 43RD STREET, SUITE 760  
NEW YORK, NY 10017

EXAMINER
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GERRITY, STEPHEN FRANCIS

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/535,544	<b>Applicant(s)</b> PREDIERI ET AL.	
	<b>Examiner</b> Stephen F. Gerrity	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/18/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Election/Restrictions**

1. Applicant's election without traverse of the invention of Group I (claims 1-7) in the reply filed on 13 November 2006 is acknowledged.
2. Claim 8 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 13 November 2006.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Information Disclosure Statement**

4. Receipt is acknowledged of an Information Disclosure Statement, filed 18 May 2005, which has been placed of record in the file. An initialed, signed and dated copy of the PTO-1449 form is attached to this Office action.

### **Drawings**

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the
  - member for preventing them [the rubber covered rollers] from rotating (claim 2);  
and

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- drawn cup roller clutches (claim 3),

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Claim Rejections - 35 USC § 112**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 2 and line 7, the use of the pronoun "it" is improper as such fails to distinctly claim the subject matter.

Claim 1, lines 2 and 3, "the goods/products to be wrapped" lacks proper antecedent basis.

Claim 2, lines 4 and 5, the use of the pronoun "them" is improper as such fails to distinctly claim the subject matter.

Claim 2, line 5, the language "to the one" renders the claim vague and indefinite.

Claim 4, line 4, the use of the pronoun "it" is improper as such fails to distinctly claim the subject matter.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

**Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Decanini (**EP 0,136,982**).

Regarding claim 1, the Decanini reference discloses an assembly comprising a member (3) for controlling the forward movement of the film (C) downstream of the spool (1) and a cutter (7) for lacerating the film, arranged downstream of the control member (3), the assembly being characterized in that, downstream of the cutter (7), it comprises a member (5) for preventing the return of the film in the direction opposite to the one in which it leaves the assembly (attention is directed to the paragraphs at the top of page 3 and page 7).

Regarding the language "for unrolling stretch film from a spool and pre-stretching the film as it is fed from the assembly towards the goods/products to be wrapped", such is found in the preamble and is a statement of intended use. It having been held that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

[T]he preamble has been denied the effect of a limitation where ... the claim or [interference] count apart from the introductory clause completely defined the subject matter [of the invention], and the preamble merely stated a purpose or intended use of

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that subject matter. On the other hand, in those ... cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning and vitality to the claims or counts. Kropa v. Robie, 187 F.2d 150, 152 [88 USPQ 478] (C.C.P.A. 1951) (collecting cases), quoted in Bell Communications Res., Inc., 55 F.3d at 620-21.

“In general, a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002) (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). “[A] claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. See, e.g., Electro Sci. Indus. v. Dynamic Details, Inc., 307 F.3d 1343, 1348, 64 USPQ2d 1781, 1783 (Fed. Cir. 2002); Rapoport v. Dement, 254 F.3d 1053, 1059, 59 USPQ2d 1215, 1219 (Fed. Cir. 2001); Pitney Bowes, 182 F.3d at 1306, 51 USPQ2d at 1166. On the

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other hand, “[i]f the body of the claim sets out the complete invention,” then the language of the preamble may be superfluous. Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310, 64 USPQ2d 1832, 1837 (Fed. Cir. 2002); Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1373-74, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001).” See Eaton Corp. v. Rockwell International Corp., 66 USPQ2d 1271, 1276 (Fed. Cir. 2003).

Regarding claim 7, the cutter (7) and return preventing member (5) of Decanini are supported by a frame (inherent in the structure). Regarding the language “that is detachable from the rest of the assembly”, such is considered functional language without any structural basis in the claim. Furthermore, structural and mechanical elements are always “detachable” from one another.

### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decanini (**EP 0,136,982**) in view of Bozza (**US 4,509,314**).

Regarding claim 2, the Decanini assembly already discloses that the rollers (5) are rotating in opposite directions, arranged in contact with each other in such a way as to allow the film (C) to pass between them and provided with a member (inherent - as they are unidirectionally rotated) for preventing them from rotating in the direction



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opposite to the one in which the film leaves the assembly. The Decanini assembly meets all of applicant's claimed subject matter with the exception of the return preventing member (rollers 5) comprises two rubber-covered rollers. The Bozza reference teaches that it is old and well known in the relevant art to provide a pair of unidirectionally rotated rubber covered rollers (15, 15') for the purpose of drawing in film in one direction and prevent the film from returning in the opposite direction - see the paragraph bridging columns 4 and 5. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Decanini reference to have had the rollers (5) be rubber covered rollers, as taught by Bozza, as the substitution of one and old structure for another is routine when it is for the same purpose.

Regarding claim 3, while neither Decanini or Bozza specifically mention that the unidirectional rotation is based on the provision of the rollers being mounted on drawn cup roller clutches, the examiner takes Official Notice that the use of drawn cup roller clutches is notoriously old and well known as a means for providing unidirectional motion for rollers. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Decanini assembly by having provided that the rollers (5) are mounted on drawn cup roller clutches as a well known structure for providing unidirectional rotation.

**12.** Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decanini (EP 0,136,982) in view of Hyer et al. (US 3,250,053).

The Decanini assembly discloses that the cutter (7) includes a blade (7a) but does not disclose that the cutter comprises an arm hinged at an intermediate position in such a way as to be able to undergo an angular displacement in a plane crossing the plane in which the film lies as it leaves the assembly, and a blade projecting transversely from one end of the arm, the arm being capable of moving angularly between an operative position, in which the blade perforates the film, and a stowed position in which the blade does not interfere with the film, there being provided an actuator for controlling the angular displacement of the arm. The Hyer et al. reference discloses that it is old and well known in the relevant art to provide a cutter (see figs. 4 and 5) that comprises an arm (82c) hinged at an intermediate position (at 82k) in such a way as to be able to undergo an angular displacement in a plane crossing the plane in which the film (28a) lies as it leaves the assembly, and a blade (82e) projecting transversely from one end of the arm (82c), the arm (82c) being capable of moving angularly between an operative position, in which the blade perforates the film, and a stowed position in which the blade does not interfere with the film, there being provided an actuator (AC2) for controlling the angular displacement of the arm - see col. 3, lines 15-41). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Decanini assembly by having substituted the cutter comprising an arm hinged at an intermediate position in such a way as to be able to undergo an angular displacement in a plane crossing the plane in which the film lies as it leaves the assembly, and a blade projecting transversely from one end of the arm, the arm being capable of moving angularly between an operative

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position, in which the blade perforates the film, and a stowed position in which the blade does not interfere with the film, there being provided an actuator for controlling the angular displacement of the arm, as taught by Hyer et al., for the reciprocating blade of Decanini, as the substitution of one old and well known structure for another is routine for a skilled artisan when the function of those structures is the same.

Regarding claim 6, as seen in figures 4 and 5 of Hyer et al., the arm (82c) with the blade (82e) and the actuator (AC2) are housed in a casing (defined by 90 and 44, 50), in which a slot (see col. 6, lines 63-71) is formed to permit the blade to project at least partially from the casing in the cutting position. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Decanini assembly by having included a casing in which a slot is formed to permit the blade to project at least partially from the casing in the cutting position, as suggested by Hyer et al., for obvious safety reasons.

#### **Allowable Subject Matter**

13. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: claim 5 requires all of the subject matter of claims 1 and 4, and further that the actuator comprises a pair of linear electromagnetic actuators acting on, respectively, the end of the arm opposite the one that bears the blade and a point intermediate between the blade and the hinge point of the arm, so that the operative position and the stowed

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position are determined by appropriately opposite forward/backward configurations of the actuators. This structure is not taught or suggested by the prior art. Furthermore, the subject matter of claim 5 would not have been an obvious modification of the subject matter disclosed by the prior art, particularly, the Decanini, Hyer et al. or Bozza references.

### **Conclusion**

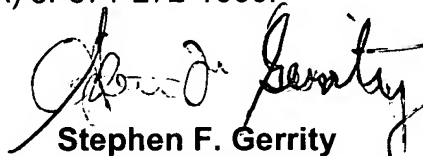
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show various machines for feeding and/or stretching web material. All are cited as being of interest and to show the state of the prior art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Stephen F. Gerrity**  
Primary Examiner  
Art Unit 3721

26 January 2007